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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,206	12/26/2001	Scott M. Frank	36968/263410 (BS01281)	2850
23552	7590	01/28/2004	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			APPIAH, CHARLES NANA	
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			2686	<i>[Signature]</i>

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,206

Applicant(s)

FRANK ET AL.

Examiner

Charles Appiah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 & 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 24-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 24 recites "the location telephone interface unit", the mobile telephone registration unit", and "the privacy unit", however, these limitations lack prior antecedent basis in the claim.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 6, 8, 20, and 41-44 are rejected under 35 U.S.C. 102(b) as being anticipated by **Haartsen (5,771,453)**.

Regarding claims 1, 8, and 20 Haartsen discloses a system and a method for providing communication services through a mobile communications network, comprising: at least one mobile telephone (120c) in communication with the mobile telecommunications network (communication between cell station 102 and terminal 120c), a home base station (110) having a mobile telephone interface unit for communication with mobile telephones (see col. 4, lines 64-67), and a mobile telephone

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registration unit, the home base station being capable of detecting the presence of the at least one mobile telephone in its coverage area (see col. 10, lines 18-22), and the mobile telephone registration unit being capable of storing information identifying the at least one mobile telephone (see col. 4, lines 47-55, col. 5, lines 6-23 and col. 9, line 61 to col. 10, line 45), and at least one telephone device (terminals 120a, 120b) in communication with the home base station (terminal 120a communicates with base station 110). See Fig. 1.

Regarding claim 6, Haartsen further discloses a home base station interface unit .

Regarding claim 9, Haartsen further discloses receiving identification information from the at least one mobile telephone, comparing the identification information received with the information stored, and if the identification information received matches information stored, sending a request to establish communication with the at least one mobile telephone (see col. 10, lines 1-53).

Regarding claim 11, Haartsen further teaches detecting the at the least one telephone device being off hook, receiving a dialed telephone number and sending the dialed telephone number to the at least one mobile telephone (see col. 6, line 60 to col. 7, line 30).

Regarding claims 12, 13 and 21, Haartsen further discloses receiving a signal from the at least one mobile telephone, the signal indicating an incoming call, ringing the at least one telephone device connected to the home base station, detecting the at least one telephone device answering the incoming call (see col. 7, lines 31-42), and

sending a message to the at least one mobile telephone device answering the incoming call (see col. 2, line 61 to col. 3, line 17 and col. 11, lines 7-17).

Regarding claim 15, Haartsen further discloses wherein the at least one telephone device is a cordless telephone (terminal 120a is cordless, see Fig. 1).

Regarding claim 17, Haartsen inherently discloses providing dial tones to the at least one telephone device and receiving a dialed number from the at least one telephone device (see col. 10, line 46 to col. 11, line 5). It is inherent that the attached terminal originating a call and for which a connection is made to the base station, is allowed to make a call using a dialed number when the remaining terminals are prevented from accessing the base station.

Regarding claim 22, Haartsen's teaching of the cellular terminal, after a successful authentication and being attached to the telephone base station, can accept calls from and initiate calls to the telephone base station (see col. 3, lines 35-40) reads on the steps of receiving by the at least one mobile telephone a destination number from the home base station and sending by the at least one mobile telephone the destination number to the mobile telecommunications network.

Regarding claim 23, Haartsen further discloses receiving a message from the home base station, wherein the message indicates at least one telephone device in communication with the home base station is ready to answer the incoming call and answering the incoming call (see col. 3, lines 43-53).

Regarding claim 45, Haartsen discloses an apparatus for providing telecommunications services to a user, the apparatus being capable of communicating

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with a wireless network and with a home base station, the apparatus comprising: a controller unit (254), a transceiver unit (250) for communicating with the wireless network, a home base station interface unit for communicating with the home base station (capability of communicating with base station 110 through antenna 122), a display unit (259) for displaying information on a display screen, a keypad unit for interfacing with a keypad (257), an audio input unit (263) and an audio output unit (261).

See Fig. 5.

Regarding claim 46, Haartsen further discloses wherein the audio output unit interfaces with an earpiece speaker (feature of speaker 261).

Regarding claim 47, Haartsen further shows wherein the home base station interface unit is capable of transmitting and receiving radio signals (see Fig. 1, base station 110 capable of communicating with units 120a-120c).

4. Claims 24, 25, 26, 32, 35, 38, 39 and 40 under 35 U.S.C. 102(b) as being anticipated by **Griffith et al. (5,598,412)**.

Regarding claim 24, Griffith discloses an apparatus for providing telephone services to a plurality of telephone devices, the apparatus comprising: a mobile telephone interface unit for controlling interface with mobile telephones the mobile telephone interface unit interfacing with the mobile telephones through radio signals (feature of BRI bases 113, 127 communicating with mobile stations 115-118 and 128-131), a transceiver connected to the mobile interface unit (RF circuitry 200 and RF interface 260, Fig. 4), a local telephone interface unit (ISDN interface 240 and RF interface 260) for interfacing with corded (112, 114) and cordless telephone devices

(115-118), and a controller (210) for controlling interactions among the mobile telephone interface unit, a telephone location interface unit and a mobile telephone registration unit (see col. 11, line 44 to col. 12, line 31). See Figs. 1 and 4.

Regarding claim 25, Griffith further discloses a mobile telephone registration unit for registering mobile telephones with the apparatus (see col. 5, line 46 to col. 6, line 23).

Regarding claim 26, Griffith's Fig. 1 shows a corded telephone interface unit (see col. 12, lines 13-31) and a cordless telephone interface unit (see col. 11, lines 43-49). See col. 3, lines 3-21.

Regarding claim 32, Griffith further discloses a mobile telephone selector, wherein the mobile telephone selector determines which mobile telephone the mobile telephone interface unit interfaces with (see col. 2, line 67 to col. 3, line 2).

Regarding claim 35, Griffith further discloses wherein the controller is capable of directing the mobile telephone interface unit to communicate with a specific mobile telephone according to a selection logic (see col. 5, line 60 to col. 6, line 6, col. 11, line 58 to col. 12, line 12).

Regarding claim 38, Griffith's teaching of employing the registration feature to track wireless terminals (see col. 5, line 35 to col. 6, line 39) reads on the selection logic being based on mobility history.

Regarding claims 39 and 40 Griffith shows the wireless terminal having a display and a keypad (308) connected to a controller/memory (333) and that a registration or identification, process being terminal-activated (see col. 5, lines 26-35),

inherently suggesting the capability of initiating a registration with the keypad or display connected to the controller serving as a user interface on the apparatus.

5. Claims 41-44 are rejected under 35 U.S.C. 102 (b) as being anticipated by **Rash et al. (5,020,094)**.

Regarding claim 41, Rash discloses a method for providing privacy to a user during a call wherein the user uses a home base station to communicate with a third party, the method comprising: receiving a private request from the originating device (feature of handheld unit placing a call (see col. 6, lines 25-48), if the originating device is a mobile telephone, disabling telephone devices connected to the home base station and if the originating device is one of the telephone devices connected to the home base station, disabling other telephone devices disabling other telephone devices and inherently sending a privacy request to the mobile telephone (base unit having a RAM for temporarily storing identification code of a first hand-held unit with, which it is communicating and does not allow other hand-held units, with other identification codes, to receive calls, from or place calls through, through, that base station, see col. 3, lines 4-15).

Regarding claim 42, Rash further discloses determining the originating device (see col. 3, lines 4-60.

Regarding claim 43, Rash further discloses disabling audio connections to the telephone devices (see col. 3, lines 10-15).

Regarding claim 44, Rash further discloses enabling telephone devices when the telephone call ends (see col. 7, lines 42-52).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 3, 14, 16 and 48 are rejected under 35 U.S.C. 103(a) as being obvious over **Haartsen (5,771,453)** as applied to claims 1, 8, and 45 above and further in view of **Bhatia et al. (WO 01/58181)**.

Regarding claims 2, 3, 14, 16 and 48, Haartsen fails to disclose wherein the communication between the home base station and the at least one telephone device or at least one mobile telephone follows Bluetooth protocols.

Bhatia discloses a system and method for connecting external devices wirelessly to a base transceiver station (BTS) via a short-range ad-hoc network such as the Bluetooth network (see abstract, Figs. 1-3). According to Bhatia, the BTS has a Bluetooth compatible transceiver for interfacing with the external equipment and also a Bluetooth adapter which is responsible for determining the address of each Bluetooth capable external equipment connected to the BTS and the type of equipment (protocol) it is (see page 5, lines 3-20).

It would therefore have been obvious to one of ordinary skill to combine the teaching of Bhatia by providing the use of Bluetooth protocols for wireless connection between a base station and external equipment with Haartsen's communication system

in order to provide short range communications with ease of installation and reduced cost as taught by Bhatia.

8. Claims 4, 5, and 19 are rejected under 35 U.S.C. 103(a) as being obvious over **Haartsen (5,771,453)** as applied to claims 1 and 8 above and further in view of **Griffith et al. (5,598,412)**.

Regarding claims 4 and 19, Haartsen fails to disclose wherein the at least one telephone device is a corded telephone device.

Griffith discloses an arrangement in which wired and wireless terminals can be interfaced to a switch through a base station using a passive bus connection (see Figs. 1, col. 3, lines 3-36 and 3, col. 11, lines 1-11).

It would therefore have been obvious to one of ordinary skill in the art to provide for wireless (cordless) and wired (corded) terminal capability of Griffith to the system of Haartsen in order to service both wired and wireless terminals using minimal equipment thus reducing infrastructure costs.

Regarding claim 5, Haartsen further shows wherein the home base station further comprises a cordless telephone interface unit (see interface to cellular terminal 120 when parked, Fig. 3).

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being obvious over **Haartsen (5,771,453)** as applied to claim 8 above and further in view of **Reed et al. (5,574,984)**.

Regarding claim 18, Haartsen fails to teach detecting by the home base station the strength of radio signals from the at least one mobile telephone is fading and if a call is established, terminating the call.

Reed discloses a method and apparatus for controlling a power level of a base station in which a fading characteristic of signals received from a mobile station is detected and compared to a threshold and the result used to make call termination decisions (see Fig. 1, col. 3, lines 30-40, col. 4, lines 1-15).

It would therefore have been obvious to one of ordinary skill in the art to provide for the detecting of signal strength and fading characteristic to the system of Haartsen in order to ensure provision of good quality communications to subscribers by terminating bad quality communication connections.

10. Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Haartsen** as applied to claims 1 and 8 above, and further in view of well known prior art Official Notice.

Regarding claims 7 and 10, Haartsen shows the base station and the mobile station having displays for displaying information to the user (see 142, 259, Figs. 3 and 5), but fails to disclose wherein the at least one telephone device is capable of receiving information identifying the at least one mobile telephone from the home base station and displaying the information to a user. The concept of displaying caller identification information on a mobile terminal is very well known in the art and as such examiner takes Official Notice that it would have been obvious to one of ordinary skill in the art to provide for the display of any desired communication information including identification

information on Haartsen's mobile telephone device and base station in order to ensure the appropriate routing of incoming calls where there are a plurality of mobile devices.

11. Claims 27-31, 33 and 34 are rejected under 35 U.S.C. 103(a) as being obvious over **Griffith et al. (5,598,412)** in view of **Haartsen (5,771,453)**.

Regarding claims 27 and 28 Griffith fails to teach a privacy unit for providing privacy to a user in communication with a remote party wherein the privacy unit is capable of interpreting a privacy request message, determining an originating device for the privacy request message and disabling audio connections to other devices

Haartsen discloses a system in which a portable telephone base station is operated with multiple devices, wherein the radio transceiver of the base station can be controlled to serially communicate with a predetermined plurality of cellular terminals and when one terminal is registered and has access to the base station all remaining terminals in the local region of the base station are prevented from access to the base station (see col. 3, lines 35-53, col. 11, lines 33-47), suggesting the capability of privacy provision in response to a privacy request and disabling audio connections to other devices.

It would therefore have been obvious to one of ordinary skill in the art to provide the privacy capability of Haartsen to the system of Griffith in order to ensure that authorized and connected devices are allowed to communicate in privacy without any undesired interruptions.

Regarding claims 29-31, Griffith fails to teach at least one docking station wherein the at least one docking station is connected to the apparatus through a cable and the docking station and further includes a battery charger.

Haartsen's Figure 2 shows the base station a housing (docking station) within which a cellular terminal may be inserted or parked and further includes a battery charger (see col. 6, lines 12-26).

It would therefore have been obvious to one of ordinary skill in the art to use Haartsen's portable base station with the docking as well battery charging capabilities with Griffith's communication system in order to have a versatile communication system with minimal components that operates efficiently in providing desired communication services.

Regarding claims 33 and 34, Haartsen further shows wherein the apparatus has a display screen displayed on a user interface of the base station and a plurality of buttons on the base station (see Fig. 2). The combination of Griffith and Haartsen fail to show wherein the mobile selector is a selection screen displayed on a user interface of the apparatus and wherein the selector is a plurality of buttons on the apparatus and each button is associated with one mobile telephone in communication with the apparatus.

However, since Haartsen shows the base station having display capability and a plurality of buttons, it would have been obvious to one of ordinary skill in the art to select and indicate a selected mobile terminal on the display including associating a

different button with one mobile telephone in communication with the apparatus for the benefit of quickly identifying a connected mobile device when desired.

12. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being obvious over **Griffith et al. (5,598,412)**.

Regarding claims 36 and 37 Griffith fails to teach wherein the selection logic is based on radio signal strength or on a history of connection quality.

However, examiner takes Official Notice that the concept of using connection quality radio signal strength for making mobile communication connections is very well known and expected in the art and as such it would have been obvious to obvious to make the mobile telephone selection based on signal strength and connection quality in order to ensure high quality communications to desired subscribers.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Weigand et al. (5,528,666) discloses a personal phone expansion system having a personal base station and a plurality of portable units.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Appiah whose telephone number is 703 305-4772. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 703 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 306-0377.

CA
January 22, 2004


CHARLES APPIAH
PRIMARY EXAMINER